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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,754	12/18/2000	Arthur A. Schein	CITI0014-CON	2823

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/09/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,754

Applicant(s)

SCHEIN ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-52 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 18 December 2000 is: a) ☒ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/077,458.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. In regard to the amendment to the specification filed December 18, 2000:

A) the amendment to page 4, line 15, can not be entered as requested, since the word "GAP" does not appear at the specified location. It is noted that this amendment should have been directed to page 4, line 17.

B) applicant's request to either add bold/italic text or to remove bold/italic text at:

- (1) page 5, lines 13, 16 & 18;
- (2) page 12, lines 8 & 12;
- (3) page 13, line 9;
- (4) page 15, line 18;
- (5) page 35, lines 6, 22 & 25;
- (6) page 36, lines 21 & 23;
- (7) page 37, line 6, 7, 12, 18, 19, 21, 25 & 26;
- (8) page 40, lines 4, 17 & 25;
- (9) page 41, lines 5, 17, 18 & 21;
- (10) page 42, line 19;
- (11) page 46, lines 6, 10, 15, 19 & 21;
- (12) page 47, lines 4 & 15;
- (13) page 48, line 23;
- (14) page 49, lines 11, 15, 18, 19 & 22;
- (15) page 50, lines 5 & 6;
- (16) page 51, lines 2 & 16;
- (17) page 52, line 26;
- (18) page 54, lines 8, 14 & 22; and

(19) page 55, line 15;

can not be entered as requested, since the Office can not replicate these changes by manual entry of these amendments.

C) the amendment to page 5, line 16, can not be entered as requested, since the number "16" does not appear at the specified location.

D) the amendment to page 12, line 9, can not be entered as requested, since the word "ad hoc" does not appear at the specified location. It is noted that this amendment should have been directed to page 12, line 8.

E) the amendment to page 12, line 12, can not be entered as requested, since the word "ad hoc" does not appear at the specified location. It is noted that this amendment should have been directed to page 12, line 18.

F) applicant insertion of the word "add" after the word "for" at page 28, line 29, is confusing since the phrase "storehouse for add data" as created by this amendment does not make sense.

G) the amendment to page 35, line 6, can not be entered as requested, since the word "Figure 1" does not appear at the specified location. It is noted that this amendment should have been directed to page 35, line 5.

H) the amendment to page 35, line 22, can not be entered as requested, since the word "Figure 1" does not appear at the specified location. It is noted that this amendment should have been directed to page 35, line 21.

I) the amendment to page 35, line 25, can not be entered as requested, since the number "12" does not appear at the specified location. It is noted that this amendment should have been directed to page 35, line 24.

K) the amendment to page 50, line 6, can not be entered as requested, since the phrase "Figure 6" does not appear at the specified location.

3. The Abstract of the Disclosure is objected to because:

A) Applicant's use of "language.system" at line 13 is confusing. Should "language.system" be --language. System--.

Correction is required. See M.P.E.P. § 608.01(b).

4. The use of various trademark(s), for example:

- A) Citicard at page 11;
- B) CitiGold at page 11;
- C) Citibank at pages 11 & 12;
- D) CitiOne at pages 11 & 12;
- E) DB2 and dBase at pages 15, 23 & 42;
- F) UNIX at page 21, 23 & 42;
- G) Oracle at pages 21, 22 & 42;
- H) IBM at page 23 & 42;
- I) MVS at page 23 & 42;
- J) Windows at page 37;
- K) Oasis IST4 at page 42;
- L) Quiken at page 48;
- M) VISA at page 53; and
- N) CIRRUS and NYCE at page 54;

has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

4.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The drawings are objected to because

- A) Applicant must provide labels, which are clearly descriptive of the function performed by component represented by the depicted feature, for each of the boxes designated as 12 in fig. 1 (37 CFR § 1.84(o)).

5.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the

examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

6. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

7. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

8. A substitute specification is required pursuant to 37 CFR § 1.125(a) because:

A) see the above objections to the amendment filed December 18, 2000; and

B) the specification filed December 18, 2000 lacks a proper top margin as required by 37 CFR § 1.52(a).

8.1 A substitute specification filed under 37 CFR § 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR § 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR § 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

8.2 The substitute specification should include each of the changes made to the disclosure.

9. Claims 21-52 are rejected under the judicially created doctrine of double patenting over claims 1-20 of U. S. Patent No. 6,226,623 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

9.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) a plurality of distribution points from which a user may send electronic messages/requests;

B) a system to route the electronic messages/request from the distribution point to a service provider; and

C) at least one service provide to process the electronic message/request.

9.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9.3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9.4 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

9.5 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.1 Claims 21-24, 30-41 & 49-52 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Adams (5,255,182).

10.1.1 In regard to claims 21-24, 30-41 & 49-52, Adams ('182) discloses a financial system in which:

A) a plurality of distribution points from which a user may send electronic messages/requests;

B) a system to route the electronic messages/request from the distribution point to a service provider; and

C) at least one service provide to process the electronic message/request.

11. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example, Adams (5,255,182) discloses a financial system in which:

(1) a plurality of distribution points from which a user may send electronic messages/requests;

(2) a system to route the electronic messages/request from the distribution point to a service provider; and

(3) at least one service provide to process the electronic message/request.

B) however, in regard to claims 25-29 & 41-48, the prior art does not teach or suggest, a communications network in which a message is processed differently base on whether the message is simple or complex and "consulting script and workflow data model rules".

12. The prior art cited in the base application serial number 09/077,458 has been considered by the examiner.

13. The examiner has cited prior art of interest, for example either: O'Deyer or Zahorik et al (EP 1049057) or Lawlor et al (6,202,054) or Symonds et al (6,302,326) or Kubitz (6,336,590), which disclose a financial system in which:

A) a plurality of distribution points from which a user may send electronic messages/requests;

B) a system to route the electronic messages/request from the distribution point to a service provider; and

C) at least one service provide to process the electronic message/request.

14. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

15.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

15.2 The fax phone number for OFFICIAL FAXES is (703) 746-7239.

15.3 The fax phone number for AFTER FINAL FAXES is (703) 746-7238.

05/04/02


Edward R. Cosimano
Primary Examiner A.U. 3629